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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,216	12/29/1999	OLEG B. RASHKOVSKIY	INTL-0319-US	2005

7590 01/15/2004

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ART UNIT	PAPER NUMBER
2611	13

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/474,216	RASHKOVSKIY, OLEG B.	
	Examiner	Art Unit	
	Christopher R Nalevanko	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *31-50* is/are pending in the application.

4a) Of the above claim(s) *51-59* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

The Applicant's prior response regarding inventorship is not sufficient. As stated in the MPEP section 2137, the Applicant is required to supply a 37 CFR 1.132 affidavit to clear up any confusion regarding the prior inventor.

Claims 31-50 directed to the same invention as that of claims 1-24 of commonly assigned Patent Application 09/196,262. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

As noted before, failure to comply with this requirement will result in a holding of abandonment of this application.

Response to Arguments

1. Applicant's arguments filed on 11/03/03 have been fully considered but they are not persuasive. Regarding Claim 31, Applicant argues, "[the claim] has been amended to call for monitoring the one video transmission for a predetermined time associated with an event being broadcast. None of the cited references do this" (page 5 lines 1-3). Lawler shows the ability to set a reminder and monitor a channel for the beginning of a show

(col. 2 lines 33-43, col. 12 lines 1-15, 50-63). In Lawler, the system monitors for certain times (for example, the beginning of a show), which is a predetermined time. Furthermore, this predetermined time is associated with an event, the event being the show itself, such as Star Trek.

Applicant further argues, "Knudson monitors the time remaining on a program guide, not through the television program itself. There simply is no way for the program guide reliably know how much time is remaining in the program...the ending time can vary. But all Knudson says is that there is displayed on the programming guide the time remaining...In contrast, the claim now calls for determining from the program itself a time associated with the event" (page 5 lines 5-15). Knudson clearly shows monitoring the time remaining in a sports program (col. 10 lines 45-60). The system is able to monitor the exact quarter and time remaining in that quarter or game (event). Furthermore, if the show or game is read as the event, the combination of De Saint Marc, Lawler, and Knudson show *monitoring when an amount of time is remaining in the event*, which is all the limitation requires.

2. Applicant's arguments filed on 11/03/03 have been fully considered but they are not persuasive. Regarding Claim 42, Applicant argues, "In contrast, De Saint Marc detects a goal, not a predetermined score" (page 5 line 20). As stated before, a predetermined score is any type of score occurring in a sporting game. The event that causes the score is predetermined before the start of every game. For example, it is predetermined that when a runner crosses home plate in baseball, a run is scored. Also, as in De Saint Marc, it is predetermined that when the soccer ball enters the net, a score has occurred.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Saint Marc in further view of Cragun et al.

Regarding Claim 42, De Saint Marc shows a method for monitoring one video transmission while a receiver is tuned to a second transmission and generating a notification when a predetermined score occurs during the one video transmission (col. 2 lines 3-9, 22-32, 34-40, col. 3 lines 11-49). Furthermore, De Saint Marc shows that the notification of the score is generated from the receiver. The receiver receives an indication of a score from the head-end, which causes the receiver to generate a notification on the display (col. 9 lines 30-52). De Saint Marc fails to show monitoring another video transmission at the receiver. Cragun shows monitoring another video transmission at the receiver (col. 2 lines 48-67, col. 3 lines 1-8, col. 9 lines 45-63, col. 10 lines 45-50, col. 11 lines 46-59, col. 17 lines 24-48, see fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify De Saint Marc with the ability to monitor video signals at the receiver, like in Cragun, in

order to remove some of the processing responsibility at the head-end. Furthermore, a predetermined score is any type of score occurring in a sporting game. The event that causes the score is predetermined before the start of every game. For example, it is predetermined that when a runner crosses home plate in baseball, a run is scored. Also, as in De Saint Marc, it is predetermined that when the soccer ball enters the net, a score has occurred.

Regarding Claim 43, De Saint Marc shows enabling the selection of the score for generating the notification (col. 2 lines 1-21, col. 8 lines 24-34). When the head-end sends the signal down to indicate a score, the head-end is enabling the selection of the score.

Regarding Claim 44, De Saint Marc provides a visual-on screen notification (col. 2 lines 1-21).

4. Claims 31, 33, 35, 37, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Saint Marc in further view of Lawler et al.

Regarding Claim 31, De Saint Marc shows a method for monitoring one video transmission while a receiver is tuned to a second transmission and generating a notification for an event (col. 2 lines 3-9, 22-32, 34-40, col. 3 lines 11-49). De Saint Marc fails to show monitoring for a predetermined time associated with an event and the notification that is generated based on that time. Lawler shows monitoring for a predetermined time associated with the video transmission and generating a notification based on that time (col. 2 lines 33-51, col. 3 lines 60-66, col. 11 lines 30-67, col. 12 lines

1-21, 45-63, col. 13 lines 7-16). Lawler shows the ability to monitor for the start time of a particular show and display when it will start. Lawler further shows the ability to set a reminder and monitor a channel for the beginning of a show (col. 2 lines 33-43, col. 12 lines 1-15, 50-63). In Lawler, the system monitors for certain times (for example, the beginning of a show), which is a predetermined time. Furthermore, this predetermined time is associated with an event, the event being the show itself, such as Star Trek. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of De Saint Marc with the time notice of Lawler so that the user would not miss favorite or frequently watched programs.

Regarding Claim 33, Lawler further shows automatically generating a notification at a given time interval (col. 12 lines 45-63).

Regarding Claim 35, De Saint Marc fails to show an article comprising a medium for storing instruction that execute a processor based system. Lawler does show a processor based system (col. 6 lines 5-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of De Saint Marc so that it was a processor based system, instead of monitored by an individual, in order to alleviate the cost and training that is required for a person to accomplish the job. Furthermore, a computer system would alleviate the possibility of human error. All other limitations of the claim are discussed with regards to Claim 31.

Regarding Claim 37, the limitations of the claim have been discussed with regards to Claim 33.

Regarding Claim 39, the limitations of the claim have been discussed with regards to Claim 35.

Regarding Claim 40, De Saint Marc shows that the system has a video receiver (col. 3 lines 10-32, col. 9 lines 30-52).

Regarding Claim 41, De Saint Marc shows that the system has a video transmitter (col. 7 lines 53-58, col. 8 lines 1-4).

5. Claims 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Saint Marc.

Regarding Claim 45, De Saint Marc fails to show an article comprising a medium for storing instructions that enable a processor-based system to execute commands. All other limitations of the Claim have been discussed with regards to Claim 42. Official Notice is taken that it is well known and expected in the art to automate a manual system with a processor-based system that executes commands. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of De Saint Marc so that it was a processor based system, instead of monitored by an individual, in order to alleviate the cost and training that is required for a person to accomplish the job. Furthermore, a computer system would alleviate the possibility of human error.

Regarding Claim 46, the limitations of the claim have been discussed with regards to claim 43.

Regarding Claim 47, the limitations of the claim have been discussed with regards to claim 44.

Regarding Claim 48, De Saint Marc fails to show a processor and a storage couple to the processor storing instructions. All other limitations of the Claim have been discussed with regards to Claim 42. Official Notice is taken that it is well known and expected in the art to automate a manual system with a processor-based system, with storage containing instructions, that executes commands. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of De Saint Marc so that it was a processor based system, instead of monitored by an individual, in order to alleviate the cost and training that is required for a person to accomplish the job. Furthermore, a computer system would alleviate the possibility of human error.

Regarding Claim 49, De Saint Marc shows that the system has a video receiver (col. 3 lines 10-32, col. 9 lines 30-52).

Regarding Claim 50, De Saint Marc shows that the system has a video transmitter (col. 7 lines 53-58, col. 8 lines 1-4).

6. Claims 32, 34, 36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Saint Marc in further of view of Lawler and Knudson.

Regarding Claim 32, Both De Saint Marc (col. 2 lines 1-9) and Lawler (see fig. 9) show the ability to present a notification. Both De Saint Marc and Lawler fail to show monitoring the time remaining. Knudson shows keeping information, and thus

monitoring, the remaining time of sports programming program (col. 10 lines 35-60, col. 11 lines 1-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify De Saint Marc and Lawler with the ability to monitor the time remaining of a program in order to inform the viewer of relevant program information.

Regarding Claim 34, Knudson further shows being able to display a notification of the end time of a sporting event, thus automatically providing a notification when a program will end in a predetermined amount of time (col. 11 lines 44-67, col. 12 lines 38-53, col. 14 lines 1-12, col. 15 lines 45-50, see fig. 7).

Regarding Claim 36, the limitations of the claim have been discussed with regards to Claim 32.

Regarding Claim 38, the limitations of the claim have been discussed with regards to Claim 34.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Nalevanko whose telephone number is 703-305-8093. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Christopher Nalevanko
AU 2611
703-305-8093

cn
January 8, 2004

VIVEK SRIVASTAVA
PRIMARY EXAMINER